

# REMARKS

## A. Amendments

Deeming proper the prior restriction requirement, the Examiner has withdrawn claims 13-15, 25-26, 37-41, 43, and 45. The Listing of Claims herein reflects the withdrawal of these claims, but the applicant reserves the right to assert the subject matter thereof in one or more continuing or divisional applications.

Claims 10, 30, and 36 are amended herein. Claims 1-12, 16-24, 27-36, 42, 44, and 46-55 remain pending.

## B. Claim Objections

The Examiner objected to claims 10, 30, and 36, asserting that they held informalities. The applicant submits that these claims are correct following entry of the amendments herein and, consequently, respectfully requests that the Examiner reconsider and withdraw these objections.

## C. 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-12, 16-24, 27-36, 42, 44, and 46-55 under 35 U.S.C. § 102(e) as anticipated by U.S. patent no. 6,839,707 to Lee *et al.* The applicant traverses and respectfully requests reconsideration in view of the following.

Lee discusses a legal management system (LMS), describing it as “a fully integrated on-line web-based company-wide communication tool.” (Col. 2, lines 31-32.) The LMS, according to Lee, is a centralized and integrated legal department management tool. (*See id.* at col. 2, lines 32-35.) The LMS indexes documents internal to an organization, including model and sample agreements, research memos, and guidelines. (*See id.* at col. 7, lines 5-9.)

The present application discloses, *e.g.*, methods and systems for computerized researching in and monitoring of legal and other professional subjects. (*See* Application at 1, lines 18–20.) Information is provided that relates to legal topics selected from a list of available legal topics. (*See, e.g., id.* at 2, lines 7–10.) The application discloses that, in some cases, it is advantageous to break down information within a given field into a number of analytical topics. The application also discloses automatic updating of information in the selected topic or topics without further action by the requester. (*See id.* at 2, lines 16–17.)

Claim 1 claims:

A system for providing legal information, the system comprising at least one computer, at least one database associated with the at least one computer for storing information related to a plurality of legal topics, and programming stored on a computer readable medium or media that causes the at least one computer to:

access within the at least one database information related to at least one legal topic, in response to a request received from a user-accessible terminal coupled with the system; and

cause the accessed information to be displayed on a display device associated with the terminal from which the request was received, the information tabulated according to a classification comprising at least two types.

The applicant respectfully submits that Lee fails to anticipate claim 1 because, among other things, it fails to disclose accessing information related to at least one legal topic. In connection with this element, the Examiner cites Lee at column 2, lines 14–22. But the cited portion discusses only certain actions involving a database and “legal/business information.” It discloses neither the existence of even a single legal topic nor any association between such a topic or topics and the “legal/business information.” In fact, Lee nowhere discloses either element.

Lee instead discusses organizing information to reflect the organization of the business or businesses that generate and use it. Thus, according to Lee, information may be classified under a practice group, a regional component of the business, or the role of the information in the business (*e.g.*, “Technology”, “Quality”, *etc.*). (*See id.* at col. 8, lines 12–21.) But none of these classifications is equivalent to an association between information and one or more legal topics. To the contrary, information relevant to any particular legal topic may be used within multiple practice groups simultaneously, and, conversely, any particular practice group may generate and use information relevant to numerous legal topics.

For example, Lee mentions the subdivision of the “Practice Groups” area into different groups such as Antitrust, Intellectual Property, International Law and Policy, and Mergers and Acquisitions. (*Id.* at col. 8, lines 29–32.) These groups are *business units*, not *legal topics*, and specifying one is far from equivalent to specifying the other. The legal topic of “conflict of laws”, for example, is relevant to each mentioned practice group. Even a legal topic such as “antitrust”, which shares the name of a practice group, is not necessarily limited to that group: it is well known in the relevant arts that the law of antitrust is relevant to the practices of intellectual property law, international law, and mergers and acquisitions.

In further contrast, the LMS in Lee:

enhances the lines of communication across all attorneys within a legal counsel department and across the globe by enabling the sharing of pertinent legal information and knowledge among teams and by facilitating approval and reviews by decision-makers through the use of on-line comment and feedback capabilities.

(Col. 1, lines 36–42.) It is well known that the “decision-makers” who conduct the discussed “approval and review[.]” tend to have responsibilities assigned by business unit, and organization of information by legal topics fails to help them carry out such responsibilities.

Lee is simply irrelevant to the present application, not least because a practice group is not the at least one legal topic in the at least one database that claim 1 refers to. Indeed, the foregoing distinctions reflect essential unlikeness: the applicant’s disclosures include a system

for legal research, but Lee discusses managing workflow and communication within legal practices.

For the foregoing reasons, the applicant respectfully submits that Lee fails to disclose or suggest accessing information related to at least one legal topic, as set forth in claim 1, and therefore fails to anticipate that claim. Pending independent claims 16, 27, 30, 36, 42, 44, 46-47, and 49-50 include limitations corresponding to those already discussed in connection with claim 1, and it is submitted that claims 16, 27, 30, 36, 42, 44, 46-47, and 49-50 are therefore allowable for the same reasons. Additionally, pending claims 2-12, 17-24, 28-29, 31-35, 48, and 51-55 depend upon one of claims 1, 16, 27, 30, 36, 42, 44, 46-47, and 49-50 and are therefore allowable based on their inclusion of allowable subject matter.

**D. Conclusion**

For these reasons, the applicant respectfully requests that the Examiner withdraw the rejections and allow the claims. To expedite prosecution of this application to allowance, the Examiner is invited to call the applicant's undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

Date: December 28, 2006

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